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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,311	05/10/2001	Joseph Neev	YBEAM-03	7823
23900	7590	12/19/2005	EXAMINER	
J C PATENTS, INC. 4 VENTURE, SUITE 250 IRVINE, CA 92618			SHAY, DAVID M	
			ART UNIT	PAPER NUMBER
			3735	
DATE MAILED: 12/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,311

Applicant(s)

NEEV

Examiner

david shay

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 17, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-25, 28-35 and 37-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25, 28-35 and 37-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17, 2005 has been entered.

The disclosure is objected to because of the form of the specification for example that portion spanning pages 76-105. Beginning with the section labeled ADDITIONAL EMBODIMENTS on page 76 there are numbered paragraphs which appear to be in the form of claims, and refer back to prior paragraph numbers with the referent "claim" but do not appear to be intended to be claims as they are in the section preceding the legend "What is claimed is" and some (e.g. 141) are not in single sentence form and make reference to drawing figures. Further the section labeled "I claim" does not have the recitations therein commencing on a separate page. Applicant should extensively amend the disclosure to put it in proper form.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendment filed March 17, 2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "at least 25% of the thermal energy is conducted into the target material" and "wherein said intermediate substance is a gas containing absorbent particles".

The amendment filed October 17, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “the intermediate substance...substantially prevents the absorbing material from penetrating into the target material” and “a heat removing device to remove heat from the target material”.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-25, 28-35, and 37-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent on “the intermediate substance...substantially prevents the absorbing material from penetrating into the target material” and “a heat removing device to remove heat from the target material”

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22-25, 39-35, 37, and 39-45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims generally, the independent claims recite an intermediate substance containing an absorbent material, however, the independent claims contain recitations of the form “the intermediate substance is [a given structure] containing high absorbing particles”. This claim structure appears to recite two separate absorbing substances, however, as no such structure or method is recited in the specification as originally filed, these recitations will be interpreted to require one absorber. In claim 30 what the period of time in the term “in a longer period of time” is intended to be compared to is unclear.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-24, 29-31, 33, 35, 38, 39, and 41-45 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Eppstein ('785).

Wherein the thermal energy is transferred in a longer period of time than if the absorber were mixed with a metallic powder; the polymer membrane is considered a thermal insulator; and transfer of at least 25% of the thermal energy is inherent in the use of carbon as the absorber.

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Claims 21-24, 29-31, 33, 35, 38, 39, and 41-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Eppstein ('699).

Wherein the thermal energy is transferred in a longer period of time than if the absorber were mixed with a metallic powder; the polymer membrane is considered a thermal insulator; and transfer of at least 25% of the thermal energy is inherent in the use of carbon as the absorber.

Claims 21-24, 29-31, 33, 35, 38, 39, and 41-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Eppstein ('578).

Wherein the thermal energy is transferred in a longer period of time than if the absorber were mixed with a metallic powder; the polymer membrane is considered a thermal insulator; and transfer of at least 25% of the thermal energy is inherent in the use of carbon as the absorber.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25, 28, 32, 34, 35, 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eppstein ('785), Eppstein ('699), or Eppstein ('578) in combination with Neev. Eppstein ('785), Eppstein ('699), and Eppstein ('578) all teach a method as claimed except the particular intermediate substance. Neev teaches the use of a conductive or metallic material as an intermediate material. It would have been obvious to the artisan of ordinary skill to employ the various intermediate materials such as agar, tracing paper, and gas as well as the conductive material as taught by Neev, since these are equivalents to the liquid of Eppstein ('785), Eppstein

('699), and Eppstein ('578); are not critical; and provide no unexpected result, thus producing a device and method such as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam, can be reached on Monday, Tuesday, Wednesday, and Thursday at (571) 272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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